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REMARKS/ARGUMENTS

This response is timely filed as it is filed within the three (3) month shortened statutory period for response to the Action. Further, as this response is hereby filed within two (2) months of the mailing date of the Action, it is understood that the shortened statutory period will expire on the date the advisory action is mailed should such advisory action not be mailed until after the end of the three-month shortened statutory period.

Claims 18-29 and 31-38 remain in the application with the Examiner having identified claims 19, 25 and 27-29 as being withdrawn from consideration.

Request for Reconsideration and Withdrawal of Final Rejection as Premature

While the Action states that Applicants' preceding amendment necessitated the new ground(s) of rejection presented in this Action, as set forth in the Action, claims 24 and 31 newly stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 6,340,175 to Hughes et al. (Hughes) in view of U.S. Patent 4,151,022 to Donaghue et al. (Donaghue).

It is respectfully submitted that such new grounds of rejection were not necessitated by the preceding amendment and thus making the present Action final is premature as, for example, Applicants have not been afforded an opportunity to present arguments against such grounds of rejection.

Furthermore, the response to the prior Office Action added claims 32-38 to more fully and completely claim the disclosed subject matter, particularly in light of the withdrawal by the Examiner of the indication of allowable subject matter from the prior Office Action. The Action, however, nowhere specifically discusses these claims and the limitations appearing therein, let alone provide an explanation as to why the so claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made.

For at least the above reasons the finality of the Action is believed premature. In view thereof, reconsideration and withdrawal of the finality of the Action is requested and notification to that effect is solicited.

Election/Restrictions

The rejoinder of claims 19 and 25-27 is requested.

As submitted in the previously filed response and NOT addressed in the Action, MPEP §818.02 entitled, "Election Other Than Express" states:

> Election may be made in other ways than expressly in reply to a requirement as set forth in MPEP §§ 818.02(a) and §§ 818.02(c).

MPEP §818.02(a), entitled, "By Originally Presented Claims" further specifically provides:

> The claims originally presented and acted upon by the Office on their merits determine the invention elected by an applicant in the application, and in any request for continued examination (RCE) which has been filed for the application. Subsequently presented claims to an

> invention other than that acted upon should be treated as provided in MPEP §§ 821.03.

MPEP §818.02(c), entitled, "By Optional Cancellation of Claims" further specifically provides:

> Where applicant is claiming two or more inventions (which may be species or various types of related inventions) and as a result of action on the claims, he or she cancels the claims to one or more of such inventions, leaving claims to one invention, and such claims are acted upon by the examiner, the claimed invention thus acted upon is elected.

In the present case, not only were claims 19, 26 and 27 previously acted upon by the Examiner, the Examiner in an earlier action had identified claims 19 and 27-29 as **"allowed"**.

Moreover, in support for the withdrawal from consideration of claims 19, 25 and 27-29, the Action states that in the earlier restriction requirement the Examiner "went on to state **examples** of the types of components that were to be elected by the use of the commonly known abbreviation, **i.e.**" (See page 2 of the Action, item 1, emphasis added.)

It is respectfully submitted that *id est* (i.e.) means "that is", and is used before clarifying the meaning of something, when elaborating, specifying, or explaining rather than when giving examples. In contrast, *exempli gratia* (e.g.) means "for example"and is used before giving examples of something.

If "for example" was intended, the Examiner should have used the correct abbreviation for "for example". Applicant was in no position to know that the Examiner was using the abbreviation "i.e." incorrectly. Moreover, Applicant should not be penalized (by the withdrawal of claims 19 and 27-29) due to the Examiner having used abbreviations incorrectly.

For at least the reasons stated above, the rejoinder of claims 19 and 25-27 is requested.

Claim Rejections - 35 U.S.C. §101

Claims 18, 20-24, 26 and 31-38 were rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter.

Such rejections are respectfully traversed.

The Action sets forth that all of the claims are composition claims, "yet recite method of using and making steps which render them indefinite."

Reference is made to MPEP §2106 IV. B. entitled "Determine Whether the Claimed Invention Falls Within An Enumerated Statutory Category" and which section provides:

> To properly determine whether a claimed invention complies with the statutory invention requirements of 35 U.S.C. 101, USPTO personnel must first identify **whether the claim falls within at least one of the four enumerated categories** of patentable subject matter recited in section 101 (i.e., process, machine, manufacture, or composition of matter).

> In many instances it is clear within which of the enumerated categories a claimed invention falls. Even if the characterization of the claimed invention is not clear, this is usually not an issue that will preclude making an accurate and correct assessment with respect to the section 101 analysis. **The scope of 35 U.S.C. 101 is the same regardless of the form or category of invention in which a particular claim is drafted.** *AT&T*, 172 F.3d at 1357, 50 USPQ2d at 1451. See also *State Street*, 149 F.3d at 1375, 47 USPQ2d at 1602 wherein the Federal Circuit explained:
>
> **The question of whether a claim encompasses statutory subject matter should not focus on which of the four categories of subject matter a claim is directed to -- process, machine, manufacture, or composition of matter -- [provided the subject matter falls into at least one category of statutory subject matter] but rather on the essential characteristics of the subject matter, in particular, its practical utility.** (Emphasis added.)

In view of the clear guidelines to Examiners provided by MPEP §2106 IV. B, the Action has failed to set forth a proper basis of rejection under 35 U.S.C. §101. Reconsideration and the withdrawal of such basis of rejection of these claims are requested.

Claim Rejections - 35 U.S.C. §112

Claims 18, 20-24, 26 and 31-38 were rejected under 35 U.S.C. §112, second paragraph as being indefinite for allegedly failing to particularly point out and distinctly claim the subject matter applicant regards as the invention.

Such rejections are respectfully traversed.

In so rejecting these claims, the Action states:

> All of the claims are composition claims, yet recite method of using and making steps which render them indefinite. A single claim which claims both an apparatus and the method of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph.

First, the Action recognizes "all of the claims are composition claims." As recognized in the Action, a composition of matter is a different statutory class of invention than either a process, machine or manufacture. In view of the clear acknowledgment that all the claims are composition claims, no relevance is seen to statements regarding a claim which claims both an apparatus and a method of using the apparatus.

As set forth in MPEP 2173.05(g):

> A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. **Functional language does not, in and of itself, render a claim improper.** *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971). (Emphasis added.)

In view of the above, reconsideration and the withdrawal of such basis of rejection of these claims are requested.

Claim Rejections - 35 U.S.C. §103

Claims 18, 20-24 and 31-38 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 6,340,175 to Hughes et al. (Hughes) in view of U.S. Patent 4,151,022 to Donaghue et al. (Donaghue).

Such rejections are respectfully traversed.

First, in so rejecting these claims, the Action asserts that limitations that relate to the composition 'adheres' and 'forms' are "essentially method limitations or

statements of intended or desired use and do not serve to patentably distinguish the claimed structure over that of the reference."

As further set forth in MPEP 2173.05(g):

> The structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where the product can only be defined by the process steps by which the product is made, or where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product. See, e.g., *In re Garnero*, 412 F.2d 276, 279, 162 USPQ 221, 223 (CCPA 1979) (holding "interbonded by interfusion" to limit structure of the claimed composite and noting that terms such as "welded," "intermixed," "ground in place," "press fitted," and "etched" are capable of construction as structural limitations.)

Independent claim 18 makes clear that, in the claimed ignition composition, the polymeric binder adheres the ignition composition to an associated inflator apparatus surface and the ignition composition adhered to the associated inflator apparatus surface forms an igniter substance having a surface area. Further, claim 18 makes clear that thermal decomposition of the polymeric blowing agent forms a porous igniter substance free of the thermally decomposable blowing agent and comprising the fuel material, the oxidizer and the polymeric binder and that the porous igniter substance has an increased surface area as compared to the igniter substance prior to decomposition of the thermally decomposable blowing agent.

It is respectfully submitted that such an ignition composition is nowhere shown by Hughes alone or in combination with Donaghue.

In this regard it is noted that neither Hughes nor Donaghue show, disclose or suggest an ignition composition adhering or adhered onto an associated inflator apparatus surface. In particular, Hughes simply discloses that the foamed igniter material thereof can be used to "surround" a squib. [See Hughes, column 2, lines 66-67.] As Donaghue is generally directed to explosive compositions, as opposed to ignition compositions for automotive safety inflatable restraint systems, Donaghue nowhere shows or suggests an inflator apparatus surface let alone an ignition composition adhering or adhered onto an associated inflator apparatus surface, as required by the claimed invention.

Claim 32 further requires that the associated inflator apparatus surface is selected from the group consisting of at least a portion of a surface of a gas generant wafer or tablet, at least a portion of an interior surface of an inflator device, at least a portion of a surface of an electrical squib, at least a portion of a surface of a damper pad, and combinations thereof. Claim 33 requires that the associated inflator apparatus surface is a gas generant material.

An ignition composition that adheres onto an inflator apparatus surface such as a gas generant material and forms a porous igniter substance is not shown or suggested by the prior art.

Independent claim 34 (with claims 35 and 36 dependent thereon) requires the ignition composition inclusion of a polymeric binder that adheres the

ignition composition to an associated inflator apparatus surface and to form an igniter substance on the associated inflator apparatus surface; and the ignition composition inclusion of a thermally decomposable blowing agent, thermal decomposition of the thermally decomposable blowing agent forms a porous igniter substance free of the polymeric blowing agent and comprising the fuel material, the oxidizer and the binder, the porous igniter substance has an increased surface area as compared to the igniter substance prior to thermal decomposition of the thermally decomposable blowing agent.

An ignition composition that includes a polymeric binder that adheres the ignition composition to an associated inflator apparatus surface and to form an igniter substance on the associated inflator apparatus surface and also includes a thermally decomposable blowing agent, thermal decomposition of the thermally decomposable blowing agent forms a porous igniter substance free of the polymeric blowing agent and comprising the fuel material, the oxidizer and the binder, the porous igniter substance has an increased surface area as compared to the igniter substance prior to thermal decomposition of the thermally decomposable blowing agent is not shown or suggested by the cited art.

As claim 34 is believed to be patentable over the prior art of record for at least the reasons discussed above, claims 35 and 36 dependent thereon are also

believed to be patentable over the prior art of record and notification to that effect is solicited.

Moreover, claim 35, similar to claim 32 further requires that the associated inflator apparatus surface is selected from the group consisting of at least a portion of a surface of a gas generant wafer or tablet, at least a portion of an interior surface of an inflator device, at least a portion of a surface of an electrical squib, at least a portion of a surface of a damper pad, and combinations thereof. Claim 36, similar to claim 33, requires that the associated inflator apparatus surface is a gas generant material.

Thus, claims 35 and 36 are believed to be further patentable over the prior art of record and notification of the allowance of these claims is solicited.

As submitted above, such claimed invention are not shown or suggested by the cited art.

Independent claim 37 requires the ignition composition inclusion of a modified cellulose polymer polymeric binder including hydroxypropyl cellulose and adheres the ignition composition to an associated inflator apparatus surface selected from the group consisting of at least a portion of a surface of a gas generant wafer or tablet, at least a portion of an interior surface of an inflator device, at least a portion of a surface of an electrical squib, at least a portion of a surface of a damper pad, and combinations thereof to form an igniter substance on the associated inflator apparatus

surface; and the ignition composition inclusion of a thermally decomposable blowing agent, thermal decomposition of the thermally decomposable blowing agent forms a porous igniter substance free of the thermally decomposable blowing agent and comprising the fuel material, the oxidizer and the binder, the porous igniter substance has an increased surface area as compared to the igniter substance prior to thermal decomposition of the thermally decomposable blowing agent.

Such an ignition composition is not shown or suggested by the cited art.

As claim 37 is believed to be patentable over the prior art of record for at least the reasons discussed above, claim 38 dependent thereon is also believed to be patentable over the prior art of record and notification to that effect is solicited.

Claim 38 further requires that the associated inflator apparatus surface is a gas generant material and the polymeric blowing agent thermally decomposes at a temperature less than the autoignition temperature of the gas generant material.

Such an ignition composition is nowhere shown or suggested by the cited art. For example, the prior art fails to show or suggest an ignition composition that adheres and forms a porous igniter substance on a gas generant material form of an associated inflator apparatus through the thermal decomposition of a thermally decomposable blowing agent.

Thus, claim 38 is believed to be further patentable over the art of record and notification of the allowance thereof is solicited.